

### **REMARKS/ARGUMENTS**

Claims 1-12, 14 and 15 are pending in the present application. Claims 1-12, 14 and 15 stand rejected. Reconsideration of the present application is respectfully requested in view of the following remarks.

Claims 1-12, 14 and 15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Maier et al., CAPLUS Abstract 134:366871 (2001). This rejection is respectfully traversed for the reasons set forth below.

CAPLUS Abstract 134:366871 (2001) is supposed to be an abstract of EP 1101764. However, this abstract is in error because it identifies several compounds that have (4-trifluoromethylpyrazol-1-yl) (or [4-(trifluoromethyl)-1H-pyrazol-1-yl]) groups attached to the central or core pyridine structure. None of these compounds are disclosed in EP 1101764, which is clearly limited to compounds that have 3-trifluoromethylpyrazol-1-yl groups attached to the central or core pyridine structure. Further, since all of the process chemistry in EP 1101764 is devoted to the production of compounds that have 3-trifluoromethylpyrazol-1-yl groups attached to the central or core pyridine structure, the EP 1101764 reference is not enabling for the production of the (4-trifluoromethylpyrazol-1-yl) containing compounds shown in the cited CAPLUS Abstract. Since the CAPLUS abstract does not contain any additional teachings concerning how the depicted (4-trifluoromethylpyrazol-1-yl) containing compounds can be made, the CAPLUS Abstract is also not enabling for these compounds.

It is established law that a reference must provide an enabling disclosure of the claimed invention in order for that reference to anticipate the claimed invention under 35 U.S.C. 102(b). See, for example, *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985). Accordingly, the CAPLUS Abstract 134:366871 cannot anticipate the invention of the present claims.

In view of the above, it is respectfully requested that the rejection under 35 U.S.C. 102(b) be withdrawn.

Claims 1-12 and 14-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maier et al., EP 1101764. This rejection is respectfully traversed for the reasons set forth below.

As discussed above, the disclosure of EP 1101764 is limited to compounds that have 3-trifluoromethylpyrazol-1-yl groups attached to the central or core pyridine structure. All of the process chemistry in EP 1101764 is devoted to the production of these compounds and there is no teaching or suggestion whatsoever of a method of making compounds that have 4-trifluoromethylpyrazol-1-yl groups attached to the central or core pyridine structure. Accordingly, the EP 1101764 reference is not enabling for the production of the 4-trifluoromethylpyrazol-1-yl containing compounds that are claimed in the present patent application.

The Examiner has not cited any additional prior art that shows a method of making the 4-trifluoromethylpyrazol-1-yl containing compounds of the present claims. Thus, the Examiner has not established that those of skill in this art would have been able to make the presently claimed compounds without undue experimentation before the priority date of the present application. Accordingly, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness with respect to the EP 1101764 reference.

Claims 1-12 and 14-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Selby et al. (WO 98/40379). This rejection is respectfully traversed for the reasons set forth below.

As acknowledged by the Examiner, the Selby et al. reference does not teach any compounds that have a 4-trifluoromethylpyrazol-1-yl group attached to a central or core pyridine structure. The teachings of the Selby et al. reference concern a broad genus of compounds that include compounds that have either a pyridine or a pyrimidine core structure. Further, as the Examiner has pointed out, the teachings of the Selby et al. reference encompass, as one possibility of many, compounds where a trifluoromethyl group can be in the 4-position on a pyrazole group that is attached to the core structure. However, none of the compounds that are

actually named or depicted in the Selby et al. reference have this structure. Further, there is absolutely no teaching in this reference that such compounds are in any way preferred. Accordingly, it cannot be said that the teachings of this reference would motivate an artisan of ordinary skill to produce such compounds. The fact that the compounds of the present claims are positional isomers of one compound of many tens of thousands of compounds disclosed in the Selby et al. reference does not establish that a person of skill in this art would be motivated to make the compounds of the present claims. There must be some additional teaching that would provide the motivation to make positional isomers of the closest compound that is disclosed in the Selby et al. reference. That additional teaching is not present in the Selby et al. reference. Accordingly, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness with respect to the Selby et al. reference.

Although applicants do not believe that the Examiner has established a prima facie case of obviousness with respect to the Maier et al. or Selby et al. references, applicants have prepared a Declaration that provides evidence of the unexpected and superior results that are obtained with compounds of the present invention in comparison to the closest compounds that are generally or specifically disclosed in the aforementioned references. The Declaration is made by Dr. Martin Hills, a scientist who is employed by the Assignee and has a great deal of experience in this field. It is respectfully submitted that any prima facie case of obviousness that may have been made with respect to either or both of the cited references would be overcome by the evidence provided in the attached Declaration.

In view of the above remarks, it is respectfully submitted that the rejection of the present claims under 35 U.S.C. 103(a) over the Maier et al. and/or Selby et al. references should be withdrawn.

The provisional rejection of claims 1-12 and 14-15 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending application serial no. 11/077,110 is respectfully traversed. However, it is respectfully submitted

that this rejection has been rendered moot by the submission of the attached Terminal Disclaimer.

In view of all of the above, it is respectfully submitted that the present application is in condition for allowance. Accordingly, issuance of a Notice of Allowance at the earliest possible opportunity is earnestly solicited.

Applicant believes that no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09879-00033-US from which the undersigned is authorized to draw.

Dated: March 14, 2007

Respectfully submitted,

By 

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Enclosures: Declaration of Dr. Martin Hills  
Terminal Disclaimer

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